REMARKS

Claims 1-10, 27, 28, 30-40, 57, 58 and 66-68 are pending. Claim 30 has been canceled. Claims 1, 31, and 66 have been amended. No new matter has been added by way of this amendment. Reconsideration of the application is respectfully requested.

It appears the Examiner has reinstated the finality of the election/restriction requirement that was entered in the Office Action mailed on March 11, 2003. Applicants' response to the election requirement was an election of Group I, claims 1-60 and 66-68, and Species I, Figs. 2a, 2b. As stated in the March 11, 2003 Office Action, claims 1-10, 27, 28, 30-40, 57-58 and 66-68 related to Species I, Figs. 2a, 2b. Here, the Examiner withdrew claims 11-26, 29, 41-56, 59 and 60, asserting that these claims were drawn to Species IV that illustrates a ring embodiment for the switch for the hand piece. In response to the requirement, Applicants wish to redirect the Examiner's attention to §806.04(d) of the M.P.E.P. which states:

"Once a claim that is determined to be generic is allowed, all of the claims drawn to species in addition to the elected species which include all the limitations of the generic claim will ordinarily be obviously allowable in view of the allowance of the generic claim, since the additional species will depend thereon or otherwise include all of the limitations thereof."

Applicants also wish to redirect the Examiner's attention to §809.02(c) of the M.P.E.P. which states:

"Upon the allowance of a generic claim, Applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all of the limitations of an allowed generic claim as provided by 37 C.F.R. 1.141."

According to the Examiner, claim 1 is generic. Therefore, Applicants respectfully wish to point out that upon the allowance of generic claim 1, then the withdrawn claims that depend therefrom should also once again be allowable and should pass to issue with the generic claim.

Claims 1-10, 27, 28, 30-40, 57, 58, and 66-68 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,026,387 to *Thomas* in view of U.S. Patent No. 6,037,724 to *Buss* et al. In response to this ground of rejection, Applicants have amended independent claims 1, 31, and 66 to more clearly recite those features of the invention that distinguish it from the cited references. Accordingly, for the reasons set forth hereafter, Applicants respectfully submit that all claims of record now distinguish over the cited references.

Claims 1, 31, and 66 have been amended to recite the limitation that the "switch ... provides its switching functionality according to a lagging effect as the monitored pressure on the switch is changed...."

U.S. Patent No. 5,026,387 to *Thomas* relates to methods and apparatus for facilitating the performance of surgical procedures such as cauterization of large blood vessels or simultaneous soft tissue dissection, and coagulation of small vessels through the use of a precisely controlled ultrasonically vibrating scalpel (see col. 1, lines 9-14). However, this reference fails to disclose the limitation that the "switch ... provides its switching functionality according to a lagging effect as the monitored pressure on the switch is changed," as set forth in amended independent claims 1, 31, and 66.

The Examiner has conceded that *Thomas* fails to disclose a switch that has a sensor monitored pressure value which reaches a high threshold and deactivates the had piece if the sensor monitor pressure value reaches a low threshold. To cure this deficiency, the Examiner has introduced U.S. Patent No. 6,037,724 to *Buss* et al. In so doing, the following statement on page 3 of the Office Action has been made:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Thomas by adding a "sensor-activated" switch as taught by Buss et al. in order to provide sufficient sensor activated switch which makes the device more ergonomic design, less tiring for the user. Furthermore, it is noted that such as a "sensor-activated" switch is merely a common switch activated by the pressure of a user's finger and deactivated by the release of the user finger.

In addition, set forth on page 4 of the Office Action is the statement that:

Thomas discloses the switch 6(a) has an inadvertent activation. The switch is a hysteresis switch 6(a); and wherein the switch provides its switching functionality according to a lagging effect.

With respect to the foregoing, the following is noted. U.S. Patent No. 6,037,724 to *Buss* et al. discloses a surgical power tool including a power console and a handheld motor unit. According to this patent, the power console provides controlled power to the handheld motor unit. Pressure sensitive switching elements on the handheld unit provide signals to the power console which are transformed into operating power to the motor unit including variable speed, speed range, forward/reverse, and safety (see *Abs.*). This reference, however, fails to cure the deficiency of the *Thomas* patent. Specifically, *Buss* et al. also fails to disclose the limitation that the "switch ... provides its switching functionality according to a lagging effect as the monitored pressure on the switch is changed," as set forth in amended claims 1, 31, and 66.

In the case of the claimed invention, the switch can function as a switch due to the hysteresis effect. Hysteresis is the lagging of an effect behind its cause, such as when the change in magnetism of a body lags behind changes in the magnetic field. The switching functionality is achieved per the lagging or retardation of the hysteresis effect when the pressure applied or forces acting upon the switch are changed, and per the temporary resistance to change from a condition previously induced in magnetism or thermo-electricity (e.g., on reversal of polarity). This concept is set forth on page 25, lines 12-18 of the specification as originally filed. With respect to the lagging function set forth in amended claims 1, 31, and 66, Applicants have read the Thomas patent in its entirety. However, this patent fails to teach or suggest the lagging concept that is set forth in amended independent claims 1, 31, and 66. If it is still the Examiner's belief that the Thomas switch includes this function limitation, then the Examiner is invited to explain himself for the record.

In sum, the *Thomas* and *Buss* et al. references, whether considered individually or in combination, fail to teach or suggest the limitation the "switch ... provides its switching functionality according to a lagging effect as the monitored pressure on the switch is changed," as set forth in amended independent claims 1, 31, and 66. Therefore, Applicants respectfully assert that these

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claims are patentable over the combination of the cited references, and a notice to that effect is earnestly solicited.

In view of the patentability of amended independent claims 1, 31, and 66 for the reasons set forth above, dependent claims 2-10, 27, 28, 30, 32-40, 57, 58, 67, and 68 are also patentable over the cited references.

Based on the foregoing amendments and remarks, this application should be in condition for allowance. Early passage of this case to issue is respectfully requested. However, if there are any questions regarding this Response, or the application in general, a telephone call to the undersigned would be appreciated since this would expedite the prosecution of the application for all concerned.

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Respectfully submitted,

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